

REMARKS

Claims 1-3, 5-8 and 10-19 are pending in the Application. Claims 10-19 have been withdrawn from consideration. Claims 1-3 and 5-8 stand rejected.

Elections/Restrictions

At the outset, the undersigned would like to note for the record that the *scathing* remarks made by Examiner O’Conner in the Office Action with regard to the Applicants patent prosecution skills and traverse of the restriction requirement were wholly unwarranted and unprofessional. The Examiner should refrain from such conduct.

As one can readily glean from Applicants’ Response to Restriction Requirement filed on November 14, 2005, Applicants’ traversal of the restriction requirement was supported by a bona fide explanation as to the impropriety of the Restriction Requirement. In fact, the impropriety of the Restriction Requirement is underscored in hindsight view of the Examiner’s responses.

In the first instance, it should be noted that both the timing of the restriction requirement, and the propriety of the Examiner’s finding of 7 different inventions (Groups I.-VII), is highly questionable in view of the record in this case. With regard to timing, MPEP 811 (regarding 37 C.F.R. .142(a)) essentially states that the examiner should, make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise, as soon as a proper requirement develops.

With regard to the issue of timing of the Restriction Requirement, Examiner O’Conner asserts (on page 3 of the Final Action) that “*another examiner choosing to examine additional inventions for free, on his or her own time, is entirely within the discretion of the other examiner... [and] in no way encumbers the current examiner with the same burden.*” Moreover, the Examiner contends (on page 5, paragraph 11) that

Applicants' traversal of the Restriction based on 37 CFR 1.142 was "disingenuous" because a restriction can be made "any time before final action" and notes that *applicant has received no action on the merits for any of the instant claims, since all of the claims have been amended or added since the last action on the merits in the instant application*. Applicants disagree with such assertions.

In particular, irrespective of an Examiner's discretionary authority, fundamental fairness dictates that a new Examiner give credence to a previous Examiner's prosecution of a patent application in certain instances, such as here where a Restriction requirement with 7 Groups of claims comes late in prosecution to the prejudice of the Applicants.

Moreover, with regard to timeliness of the Restriction Requirement, Examiner O'Conner's reliance on the Applicants' amendments of "all previous inventions" as justification for the Restriction Requirement is in stark contradiction to the Examiner's assertion (on page 10) that *all rejected claims are drawn to the same invention claimed in the application* prior to Applicants request for continued examination, which Examiner uses to support the issuance of this first action as a Final Action. In particular, on pages 9-10 of the Office Action, in support of issuing this Final Action, the Examiner contends that the amendments to claims 1 and 5 are irrelevant and lack patentable weight, and that "all rejected claims are drawn to the same invention" prior to the RCE.

On the other hand, the Examiner's justification for the timing of the Restriction Requirement is based, in part, on that all the claims have been amended and have not yet received action on the merits. This statement is incorrect. Restricted claim 12 is in its original form, has never been amended, and has been examined on several occasions. Moreover, it should be noted that independent claims 11, 13, 14 and 16 (examined several

times) were amended to include features similar to those added in claims 1 and 5. Thus, by the Examiner's own admission, claims 11, 13, 14 and 16 would be found by the Examiner to be drawn to the same invention claimed prior to the RCE. This stark contradiction underscores the impropriety of the Restriction Requirement and/or the Finality of this Action. In this regard, the restriction requirement is seemingly untimely at least with regard to claims 10-16 and out of fundamental fairness, these claims should be maintained in the current application.

The Examiner further contends that a *prima facie* showing of "serious burden" is shown based on the separate classification of the claim groups as set forth in the Restriction Requirement. While this general statement may be true, there must be reasonable basis for the Examiner's classification. Here, the Examiner's proposed claim classifications appear to be erroneous on their face. Most telling, claims 1-16 have been examined on several occasions and each of the claims 1-16 have been rejected as being anticipated by a single reference, Herz. In this regard, the Examiner's classification of claims 1-16 in 5 separate classes is wholly inconsistent with the previous rejections – it seems highly unlikely that a single reference Herz in class 705 can be used to support anticipation over such disparate classes and subclasses for Groups I~V as set forth in the Restriction Requirement.

Moreover, the Examiner's explanation in support of the Restriction Requirement is rather vague and not on point. When claims are classified, the Examiner must examine and analyze the claimed inventions in their entirety, i.e., viewing more than the individual elements of the invention as a basis for restriction. Overall, the claimed inventions 1-16 and even claims 17-19 have many common element and features, such that the claims may

be deemed to be different definitions of the same or similar inventions, but varying in breadth or scope of definition. The various classifications are seemingly random and lack a reasonable basis. Accordingly, for at least the above reasons, withdrawal of the restriction requirement is requested.

Claim Rejections

Claims 1-3, and 5-8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Herz et al. (hereinafter “Herz”). At the very least, claims 1 and 5 are patentable over Herz. This Office Action, like previous Actions, fails to present a *prima facie* case of anticipation with specific reference to sections of Herz showing how the claimed features are disclosed. The Examiner should note that it is his burden to formulate a reasonable basis for the rejection, and it is not the Applicant’s burden to explain how Herz differs from the claimed invention, although Applicants have previously demonstrated how the claimed inventions differ from Herz (see, Applicants’ response filed on October 21, 2004).

The impropriety of the anticipation rejections is illustrated by Examiner’s finding that the “means for” recitations are “drawn to extensively functional language” and, thus, “afforded little patentable weight”. Examiner fails to recognize that “means for” elements are properly modified by functional language. Accordingly, the Examiner’s failure to recognize the functional language of claims 1 and 5 renders the claim rejections legally deficient on their face. Accordingly, the anticipation rejections should be withdrawn.

Moreover, Applicants request withdrawal of the Finality of this Action. The basis for this Final Action appear to be Examiners’ finding the added claim language is functional and has little patentable weight. However, as noted above, functional language is allowed and legally proper in “means for” claim recitations. Thus, the subject matter of

the amended claims should be afforded consideration. Overall, the issuance of a first action Final Action is improper and fundamentally unfair.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Frank V. DeRosa", is written over a horizontal line.

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